

**THIS DECISION IS NOT
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OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Allianz Life Insurance Company of North America

Serial No. 75587761

Eric D. Paulsrud of Leonard, Street and Deinard for
applicant.

Russ Herman, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Quinn, Hohein and Rogers, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Allianz Life Insurance
Company of North America to register the mark WEALTHCARE
for "insurance services, namely, underwriting, claims
processing, claims administration, consultation and
brokerage, in the fields of health care insurance, life
insurance and annuities."¹

¹ Application Serial No. 75587761, filed November 12, 1998, based
on an allegation of a bona fide intention to use the mark in
commerce. Applicant subsequently filed an amendment to allege
use wherein applicant alleged first use of the mark anywhere and
first use in commerce on February 2, 1999.

The trademark examining attorney ultimately refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, is generic.

Applicant, while maintaining that the mark is inherently distinctive, asserted, in the alternative, a claim under the provisions of Section 2(f) of the Trademark Act that its mark has acquired distinctiveness for its services in commerce. The examining attorney, in response to applicant's alternative claim, simply maintained that a claim of acquired distinctiveness was futile in view of the genericness of the term sought to be registered. The examining attorney took no explicit position on the sufficiency of the Section 2(f) evidence in the event that the term is found not generic, but rather merely descriptive. In support of the refusal, the examining attorney introduced excerpts of articles retrieved from the NEXIS database.

When the refusal of genericness under Section 2(e)(1) was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

The essence of applicant's argument is that the record lacks clear evidence of genericness. Applicant asserts

that there is no evidence that WEALTHCARE is the name of the genus of applicant's services, or that the public recognizes and refers to the genus of the identified services by the name WEALTHCARE. Applicant, although acknowledging that the examining attorney's NEXIS evidence shows "occasional use" of the terms "wealth care" and "wealthcare" in a generic/descriptive manner, points out that many of the references are from foreign publications. Further, applicant indicates that none of the references involve the type of insurance services offered by applicant. In this connection, applicant states that the examining attorney failed to support his statements that "goal based financial advice" and "professional management and planning of one's financial portfolio" "could very well include information about insurance services." Applicant highlights the fact that the record is devoid of evidence showing applicant or any third party in the field using the term in a generic manner or descriptive manner in connection with insurance services. Applicant also argues that the term is not even merely descriptive, but rather is, at worst, only suggestive. In the event that the term WEALTHCARE is found to be merely descriptive, applicant alternatively claims the benefits of Section 2(f), pointing to applicant's sales and advertising efforts in connection

with the proposed mark. In support of its position, applicant submitted the declarations of two officers, together with promotional and informational materials.

The examining attorney maintains that the term "wealth care" is the name of "a major business category that includes income tax planning, estate planning, retirement planning and insurance." According to the examining attorney, "wealth care" is "a term of art routinely used in the financial and insurance industries to identify products and services designed to safeguard investment assets while still providing a maximum investment return." The examining attorney claims that "[a]lthough not voluminous, the NEXIS evidence of record provides sufficient proof that the public understands WEALTHCARE to refer to the genus of services identified in the application."

A procedural matter requires our attention, however, before turning to the merits of this appeal. The first refusal raised by the examining attorney was based on mere descriptiveness under Section 2(e)(1). In response, applicant argued against the refusal, maintaining that its proposed mark is inherently distinctive. Nonetheless, in the same response, applicant also raised its alternative claim of acquired distinctiveness. The examining attorney, in his Office action dated April 25, 2003, stated that "the

mark is so highly descriptive of the goods [sic] and services offered that a request for registration pursuant to Section 2(f) of the Act must be denied....The term has acquired generic significance and cannot be rescued by proof of secondary meaning regardless of the amount of evidence." After applicant filed a response, the examining attorney issued a final refusal based on genericness. In his appeal brief, the examining attorney reiterated that "[s]ince applicant's mark is the common descriptive name of the services provided, it is disqualified from registration under Section 2(f) of the Trademark Act."

When an applicant claims acquired distinctiveness in the alternative, the examining attorney should treat separately the questions of (1) the underlying basis of refusal; and (2) assuming the matter is determined to be otherwise registrable on a showing of acquired distinctiveness, whether acquired distinctiveness has actually been established. TMEP §1212.02(c) (3d ed. 2d rev. May 2003). In the present case, the examining attorney did not follow the proper procedure. In maintaining the genericness refusal, the examining attorney essentially indicated that no amount of Section 2(f) evidence could overcome the refusal. What the examining attorney failed to do was to consider the possibility that the mark would be

found not to be generic, but rather merely descriptive, and then further consider the sufficiency of the evidence of acquired distinctiveness.

Given the examining attorney's original refusal and his later position on genericness, it is apparent that, at best, the examining attorney would view applicant's proposed mark as highly descriptive. In such cases, a greater evidentiary showing must be made in order to establish acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988). It is reasonable to presume, therefore, that the examining attorney would view the Section 2(f) evidence as insufficient to overcome his view that the proposed mark is highly descriptive. In view thereof, and in the interests of judicial economy, we will also, in this decision, consider the issues of mere descriptiveness and the sufficiency of applicant's claim of acquired distinctiveness.

Genericness

A designation is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. In *re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir.

2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a designation is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, supra. The United States Patent and Trademark Office has the burden of establishing by "clear evidence" that a designation is generic and thus unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a designation may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

At the outset, we take judicial notice of the meanings of the terms comprising applicant's proposed mark. The term "wealth" is defined as "large possessions; abundance of things that are objects of human desire; all property that has a money value or an exchangeable value." The term

"care" means "charge, supervision, management; responsibility for or attention to safety or well-being." Webster's Third New International Dictionary (unabridged ed. 1993).

We first turn to consider the category or genus of services and, in this connection, it is imperative to understand the specific nature of the services rendered under the proposed mark. Applicant's services are recited as "insurance services, namely, underwriting, claims processing, claims administration, consultation and brokerage, in the fields of health care insurance, life insurance and annuities." Applicant's promotional materials reveal that the product sold via its services under the mark is a single premium immediate annuity; the annuity is protected from risk, and monthly payments to the insured are guaranteed until death. If death occurs prior to receiving income equal to the insured's paid premium, then payments are guaranteed to continue to the insured's heirs. Applicant lists the benefits to consumers of its single premium immediate annuity as follows: a guaranteed retirement fund totally protected from risk; absolutely no possibility of outliving one's income; a way for one's income to keep pace with the stock market; the potential for up to 60% additional income if disability or serious

illness strikes; and a guarantee that all unused funds will be passed on to one's heirs.

Based on the record, we find that applicant's genus of services may be broadly characterized as "insurance services." More specifically, the genus of applicant's services is accurately identified by the recitation of services in the application.

We next must determine whether the term WEALTHCARE is understood by the relevant public primarily to refer to that genus of services. The relevant purchasers are ordinary consumers of insurance services, including such services which involve annuities.

The only evidence relied upon by the examining attorney in support of the genericness refusal are excerpts of articles retrieved from the NEXIS database. Many of the excerpts (by our count, fifteen of the thirty-three stories) are from foreign publications or from wire services. As for the foreign publications, we have no idea whether or not the publications were distributed in the United States such that the stories therein had any exposure to prospective consumers in this country. In re Men's International Professional Tennis Council, 1 USPQ2d 1917, 1918 (TTAB 1986). Further, as to the wire services, excerpts of wire service reports or releases, in

appropriate circumstances, can be accorded some probative value. In re Cell Therapeutics Inc., 67 USPQ2d 1795, 1798 (TTAB 2003). There is nothing in the record, however, to indicate that these wire service reports have been broadcast or otherwise distributed so as to reach appreciable members of the relevant public. Accordingly, the wire excerpts of record have much less probative value than the excerpts appearing in newspapers and magazines. In re Men's International Professional Tennis Council, supra at 1918 n.5.

The following representative excerpts comprise the examining attorney's most probative NEXIS evidence:

The conference highlighted the opportunities in PFP but also explained the downside of the wealth-care arena. (*Accounting Today*, January 29, 2001)

Today, however, let's focus on a related "Health-Care/Wealth-Care" topic, long-term-care insurance. (*Capital*, April 11, 2000)

Our wealth care pledge provides complete coverage, no deductibles; go to the agent of your own choosing. (*Pittsburgh Post-Gazette*, October 22, 1994)

1st Global uses 10 areas of wealth care concern to accomplish this including tax planning, investment planning, retirement planning, disability and income protection.... (*Practical Accountant*, September 2003)

....how to successfully build a wealth care business into their existing practice.

(Accounting Today, July 21, 2003)

It will focus on what Carter calls "wealth care" products....

(The State Journal, August 27, 2001)

Contrary to the common perception of most accountants, a comprehensive wealth care practice entails much more than asset management services.

(Accounting Today, July 23, 2001)

"We plan to offer sophisticated and proactive 'wealth care' services to families...."

(Charleston Daily Mail, July 13, 2001)

The second, entitled "The Wealth Care Kit," discusses insurance, income tax planning and estate planning, among other issues.

(Newsday, May 19, 2002)

A review of applicant's promotional materials shows that applicant consistently uses the term WEALTHCARE with initial capital letters, and that applicant's use is more in the manner of a service mark than a generic term: "Now you can be sure your wealth is cared for. There is WealthCare. WealthCare is a new type of single premium immediate annuity. WealthCare offers benefits not available from any other plan. WealthCare offers you more when you need it most. WealthCare. When you care about your money." Applicant, in its promotional literature,

also states: "You have cared for your assets all your life. Now, it is time for your assets to care for you."

In support of its claim of registrability, applicant submitted the declaration (along with promotional materials) of Carolyn Cosgrove, the assistant secretary of applicant's predecessor in interest (dated March 8, 2000). The present applicant, that is, the assignee, updated the information furnished by Ms. Cosgrove by way of the declaration of Charles Wikelius, a senior vice president of applicant. The declaration is accompanied by additional promotional materials. Mr. Wikelius asserts that applicant offers a line of insurance and annuity products under the mark WEALTHCARE, and that applicant has used the mark WEALTHCARE for its insurance services and products in commerce continuously since at least as early as February 1999. Mr. Wikelius goes on to state that applicant's WEALTHCARE insurance products and annuities are now sold through approximately 800 agents nationwide; that applicant has received premiums exceeding \$80.7 million through the sale of over 1,100 policies across the country; that advertising expenditures have been "significant and ongoing" since the mark was first introduced in 1999; that applicant now has a family of products available under the WEALTHCARE brand (including WEALTHCARE ELITE with premiums

exceeding \$680,000); and that as a result of applicant's use and promotional activities involving its mark WEALTHCARE, consumers recognize the mark as indicating applicant as the source of its annuities. In this connection, Mr. Wikelius states that no other company in the insurance field uses the term WEALTHCARE as a mark for insurance products or services and that applicant's use has been exclusive in the field since February 1999. Mr. Wikelius further indicated that he is unable to provide the exact amount applicant has spent advertising the mark and the services rendered thereunder because applicant does not account separately for such expenditures.

We find that neither the quality nor the quantity of the examining attorney's evidence is of the caliber upon which to affirm the genericness refusal.² Under the applicable case law, the examining attorney's burden to establish genericness is not an easy one. Undoubtedly, the NEXIS evidence herein includes some evidence of what would appear to be generic or highly descriptive uses. In some instances, however, the NEXIS evidence is of questionable value. The context of use of the terms "wealth care" or

² As noted earlier, the examining attorney himself recognized that his evidence of genericness is "not voluminous." (Brief, p. 6).

"Wealth Care" is unclear in certain of the excerpts, that is, we are unable to determine what exactly the terms are referring to. Other uses seem to focus on financial planning, or the term "Wealth Care" is capitalized. One of the articles (not reproduced above) uses "wealth care" to refer to hospitals' practice of giving better medical care to paying patients. Thus, some of the articles relied upon by the examining attorney are ambiguous or irrelevant, and are neutral in our analysis. See *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999).

The record is also devoid of direct evidence of any generic uses of "wealthcare" or "wealth care" by competitors in the insurance field. Moreover, applicant's promotional materials do not show any clear misuse of the term in a generic manner. Rather, applicant consistently uses WEALTHCARE in a service mark manner.

Ultimately, if we are to find that WEALTHCARE is generic, we must conclude that the evidence clearly shows that the term is understood by the relevant public primarily to refer to the name of the category of insurance services offered by applicant. Based on the relatively sparse record introduced by the examining attorney, we are unable to conclude that the evidence clearly shows that

applicant's proposed mark is generic. In re Merrill Lynch, Pierce, Fenner and Smith, Inc., supra.

Mere Descriptiveness

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); and In re MBAssociates, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or

intended use. That a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them." In re Tower Tech Inc., 64 USPQ2d 1314, 1316-17 (TTAB 2002); see also In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998); In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corporation, 226 USPQ 365 (TTAB 1985).

Although we have determined that the NEXIS evidence falls short of clearly showing the genericness of the term WEALTHCARE for applicant's insurance services, we find that the evidence is sufficient to show the highly descriptive nature of the term for such services. Applicant assures prospective purchasers that, by availing oneself of applicant's services, "your wealth is cared for." The term WEALTHCARE is merely descriptive of a function or purpose of applicant's insurance services, that is, to care for or manage the insured's wealth. There is nothing in the mark that is incongruous or ambiguous, nor is there anything

which would require the exercise of imagination, cogitation or mental processing or necessitate the gathering of further information in order for the highly descriptive significance of the term to be readily apparent to purchasers of applicant's insurance services.

Further, we note that the NEXIS excerpts of record provide more support for a descriptiveness refusal than they do for the genericness refusal. That is, the evidence has to be both clear and specifically indicate use of the proposed mark as the name of a class of services for it to establish that the proposed mark is generic. On the other hand, the evidence supports a descriptiveness refusal even when it illustrates various descriptive meanings, because it shows that consumers are predisposed to view the term as having one of the various descriptive connotations, depending on the context of use.

Acquired Distinctiveness

In view of our finding that applicant's mark is merely descriptive, we turn to applicant's alternative claim of acquired distinctiveness under Section 2(f). On the Section 2(f) issue, applicant has the burden of proving that its designation has acquired distinctiveness. In *re* Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended

that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha International Corp., supra at 1008. In this case, that standard is difficult to meet in view of the highly descriptive nature of applicant's term.

As noted above, applicant submitted the declaration of Mr. Wikelius, a senior vice president of applicant. Given that the term WEALTHCARE is highly descriptive when used in connection with applicant's services, we find that the totality of the Section 2(f) evidence is insufficient to establish acquired distinctiveness.

Applicant's revenues in the form of premium payments suggest that applicant has enjoyed some relatively modest degree of success. It is difficult, however, to accurately gauge the level of this success in the vast insurance field in the absence of additional information such as applicant's market share or how it ranks in terms of sales in the industry. Standing alone, the total premium figures (around \$81 million) and number of insureds (about 1,100) appear to be less than impressive in the large insurance field. In any event, the premiums paid show only the popularity of applicant's single payment immediate annuities, not that relevant customers of such insurance

services have come to view WEALTHCARE as applicant's source-identifying mark. In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and In re Recorded Books Inc., 42 USPQ2d 1275 (TTAB 1997). Further, although applicant states that it has extensively promoted its services, no figures relating to expenditures have been submitted (and, indeed, such figures are not separately kept for applicant's mark). Lastly, applicant's proposed mark has been in use since only 1999, a relatively short period of time.

We conclude that the evidence is insufficient to support registration of applicant's highly descriptive mark on the Principal Register pursuant to the provisions of Section 2(f). Given the highly descriptive nature of WEALTHCARE for applicant's insurance services, much more evidence (especially in the form of direct evidence from customers) than what applicant has submitted would be necessary to show that the mark has become distinctive of applicant's services. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the applicant to establish acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., supra; and In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra.

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Decision: The refusal to register on the ground of genericness is reversed. The refusal to register on the ground of mere descriptiveness is affirmed, and we find that applicant has failed to establish acquired distinctiveness of the term WEALTHCARE for its insurance services.